

Appl. No. : 10/670,132  
Filed : September 24, 2003

### REMARKS

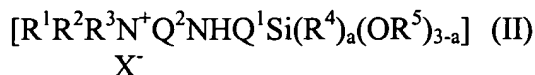
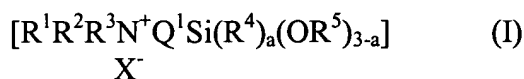
Claims 1 and 5-14 have been amended, Claims 2 and 3 have been cancelled, and new Claims 19-23 have been added. As a result, Claims 1 and 4-23 remain pending in the present application. Support for the amendments and new claims can be found in the specification and claims as filed. Accordingly, the amendments do not constitute the addition of new matter. Reconsideration of the application in view of the foregoing amendments and following comments is respectfully requested.

#### Rejection of Claims under 35 U.S.C. § 102-Saito et al.

The Examiner rejected Claims 1-3 and 15-18 under 35 U.S.C. § 102(b) as being anticipated by Saito et al. (U.S. Patent No. 4,996,257) and DE 3912878. U.S. Patent No. 4,996,257 is the corresponding patent in the U.S. for DE 3912878A1. References herein to column and line numbering will be to U.S. Patent No. 4,996,257.

According to M.P.E.P. 2131.01, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”

Saito et al. discloses a polyorganosilsesquioxane fine powder which is surface treated with an organosilicon compound containing a quaternary group, represented by the formula (I) or (II):



The polyorganosilsesquioxane fine powder which is surface treated with an organosilicon compound containing a quaternary group shows excellent physiological activity and can be advantageously used for marine paints. Saito et al. necessarily requires that the organosilicon coating compound have a quaternary ammonium salt. The importance of the quaternary ammonium salt is disclosed in column 1, lines 60-63, which states that the coating compound has a quaternary ammonium group and excellent physiological activity. Also, Saito et al. at column 3, lines 50-63 discloses preferred quaternary ammonium groups that “impart high physiological activities, chemical stabilities and good handling properties to the resulting organosilicon compounds.”

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The present claims recite an aryl aminofunctional compound and/or HCl salts thereof. The recited compounds comprise amino groups having at least a hydrogen group. Hence, the recited compounds do not comprise quaternary ammonium salts. Accordingly, Saito et al. does not anticipate the present claims because each and every element of the claims is not found in Saito et al.

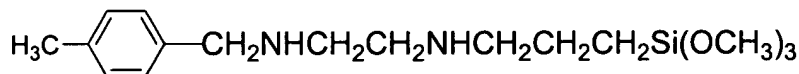
Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §102(b) with respect to Saito et al.

Rejection of Claims under 35 U.S.C. § 102-JP 8325439

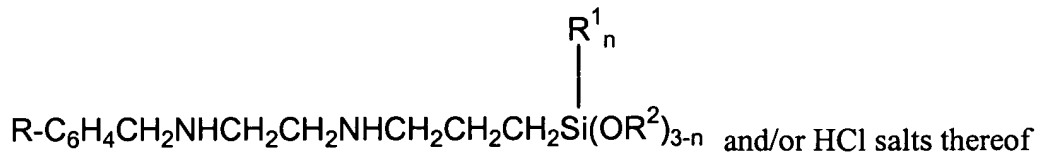
The Examiner rejected Claims 1-3 and 15-18 under 35 U.S.C. §102(b) as being anticipated by JP 8325439.

JP 08325439 discloses a silane coupling agent which consists of an amino silane

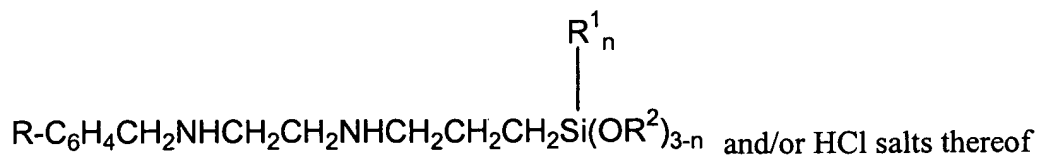
compound with the formula: 
$$\text{R}^1\text{-C}_6\text{H}_4\text{-CH}_2\text{NH}(\text{CH}_2\text{CH}_2\text{NH})_m(\text{CH}_2)_n\text{Si}(\text{OR}^2)_3$$
, wherein  $\text{R}^1$  is a hydrogen atom, a methyl group, or an ethyl group;  $m$  is an integer from 0 to 3;  $n$  is an integer from 1-6, and  $\text{R}^2$  is an alkyl group of 1-10 carbons. Analysis of JP 8325439 reveals that only methyl as the aryl bound substituent was made and tested, namely:



As amended, there are two independent claims directed to compositions, Claims 1 and 19. Claim 1 recites “[a]n aryl aminofunctional silane compound having the formula:



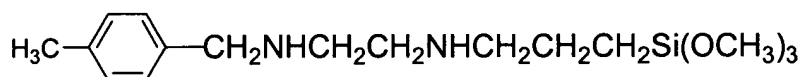
wherein  $\text{R}$  is an alkyl group having  $\pm 2$  to 6 carbon atoms;  $\text{R}^1$  is an alkyl group having 1 to 6 carbon atoms;  $\text{R}^2$  may be the same or different and are independently selected from alkyl groups having 1 to 6 carbon atoms; and  $n$  has a value of 0. Claim 19 recites “An aryl aminofunctional silane compound having the formula:



wherein R is an alkyl group having 1 to 6 carbon atoms; R<sup>1</sup> is an alkyl group having 1 to 6 carbon atoms; R<sup>2</sup> may be the same or different and are independently selected from alkyl groups having 1 to 6 carbon atoms; and n has a value of 1.”

According to M.P.E.P. 2131.02, “[a] generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus. The species in that case will anticipate the genus.” Also, in M.P.E.P. 2131.02, “[w]hen the compound is not specifically named, but instead it is necessary to select portions of teachings within a reference and combine them, e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated.”

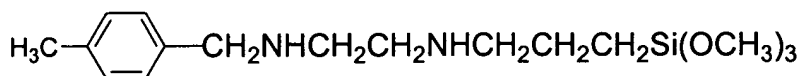
As amended, Claims 1 and 19 do not include the only compound made and tested in JP



8325439, namely:

Applicant respectfully asserts that Claims 1 and 19 are not anticipated by JP 08325439 with the support of M.P.E.P. 2131.02. To arrive at a compound of Claims 1 and 19, one would have to select portions of teachings of JP 08325439 and combine them. However, in JP 08325439, the parameters are not sufficiently limited or well delineated. In JP 08325439, the number of possible compounds included in the generic formula is so vast that it would be very difficult to draw a structural formula or write the name of each. Therefore, the generic formula of JP 08325439 cannot anticipate amended Claim 1 and new claim 19.

Moreover, when a generic structure is disclosed in a reference, one may look to the preferred embodiments to determine which compounds can be anticipated. JP 08325439 discloses a preferred embodiment to be:



Hence, one of ordinary skill in the art would not be able to envision compounds of Claims 1 and 19 with the generic

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chemical formula of JP 08325439, in view of the disclosure of the preferred embodiment having a methyl group on the aryl ring. Claims 1 and 19 would not allow compounds with a methyl group as a substituent on the aryl ring. This particular preferred embodiment of JP 08325439 therefore does not anticipate the compounds of Claims 1 and 19.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. §102(b) with respect to JP 8325439.

Amendments to Claims 5-8 and 11-14

Claims 5-8 and 11-14 have been amended to properly name the substituent on the aryl group. Claims 5-8 and 11-14 originally recited a "methyl group" where the substituent on the aryl ring should have been referred to as an "ethyl group" or "propyl group."

CONCLUSION

In view of the foregoing amendments and comments, it is respectfully submitted that the present application is fully in condition for allowance, and such action is earnestly solicited.

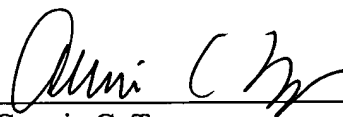
The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call the undersigned in order to resolve such issue promptly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: December 30, 2004

By: \_\_\_\_\_

  
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